

Remarks:

- A) R1 Claims 1 to 10a, 10b, and 11 are pending in the application.
- B) Applicant acknowledges the entry of previous amendments to claims 1, 2, 4, 5, 7, 10a, 10b, and 11.
- C) Applicant acknowledges the Examiner's withdrawal of the previous formalities based objections to claims 4 and 7.
- D) Applicant acknowledges the Examiner's withdrawal of the previous rejection under 35 U.S.C. §112 first paragraph in view of previous amendments to claim 7. Applicant proposes recasting claim 10a along the lines of the non-objectionable wording of claim 7. Amending claim 10a in compliance with the Examiner's invitation along the non-objectionable wording of claim 7 is not believed to constitute a new matter.
- E) Applicant acknowledges the Examiner's withdrawal of the previous rejection of claim 10b under 35 U.S.C. §112 sixth paragraph.
- F) Applicant acknowledges the Examiner's withdrawal of the previous rejections to claims 1 to 11 under 35 U.S.C. §101.

G) Applicant acknowledges the Examiner's withdrawal of the previous requisition under 37 C.F.R. 1.126 concerning the numbering of the claims. Applicant confirms dependence of claim 11 from claim 10b. Claim 11 has been appropriately amended in accordance with the Examiner's invitation to correct the clerical error. Applicant thanks the Examiner for pointing out the clerical error. Amending claim 11 in compliance with the Examiner's invitation is not believed to constitute a new matter.

H) Claims 10b and 11 have amended to relate to a --wireless mobile station--. Support for the amendment is found on page 4 last paragraph of the original application.

I) Applicant acknowledges the replacement of the abstract. Applicant acknowledges the Examiner's withdrawal of the previous objection to the abstract under MPEP Sec. 608.01(b).

J) Applicant acknowledges the Examiner's withdrawal of the previous objection to the specification concerning the "SIM/RUIM 144" element.

K) Amendments mirroring amendments to the independent claims have been made to the three consistatory paragraphs beginning with paragraph 4 on page 2. It is submitted that no additional subject matter has been introduced by the amendment.

L) Claims 1 to 10a, 10b, and 11 stand rejected.

M) Claims 1 to 10a, 10b, and 11 are now twice rejected. Original claims 3, 6, 8, and 9 are now twice rejected.

Arguments:

Double patenting rejections:

A) The Examiner has raised a nonstatutory double patenting rejection at point 4 of the outstanding Office Action. In order to “prevent the unjustified or improper timewise extension of the ‘right to exclude’ granted and to prevent harassment by multiple assignees”, the Examiner invites the Applicant to submit a terminal disclaimer under 37 C.F.R. 1.321 (c) or 37 C.F.R. 1.321(d).

Applicant respectfully submits that submitting a terminal disclosure under 37 C.F.R. 1.321(d) has been obviated by the assignment of the present application to Research in Motion. Both the issued US Patent 7,222,340 and the present application are commonly assigned. A copy of the Assignment was provided in response to the Missing Parts requisition. Applicant is currently taking steps to record the Assignment with the USPTO. A copy of the Assignment is enclosed in the Appendix.

Applicant respectfully submits that submitting a terminal disclosure under 37 C.F.R. 1.321(c) would not be effective to adjust patent terms because the terms of the issued patent 7,222,340 and of the eventual patent stemming from the application herein are the same as both were filed on the same date.

Applicant respectfully requests withdrawal of the double patenting rejection.

B) In the first paragraph of point 5 of the final Office Action, the Examiner issued a provisional rejection under the doctrine of obviousness-type double patenting.

Applicant respectfully submits that the provisional rejection raised by the Examiner is improper as the filing in view of which the Examiner finds the present application objectionable has issued to patent now U.S. Patent 7,222,340. The Examiner is respectfully directed to MPEP § 804 ¶ 8.35.

Applicant respectfully requests that this improper provisional double patenting objection be withdrawn.

C) In the second paragraph of point 5 of the final Office Action, the Examiner seems to have attempted to issue a rejection on the ground of nonstatutory double patenting based solely on improper timewise extension of patent rights.

Applicant respectfully submits that the Examiner failed to articulate a proper rejection. In particular, the Examiner failed to show that the entirety of subject matter claimed in the instant application is fully disclosed in the issued U.S. Patent 7,222,430. Also, the Examiner failed to show that the instant application and the issued patent claim common subject matter. Further, the Examiner failed to show the extent to which the claimed subject matter is covered in the issued patent.

Applicant respectfully requests that this improper double patenting objection be withdrawn.

D) Applicant respectfully submits that the provisional rejection articulated by the Examiner in the first paragraph of point 5 of the final Office Action and the rejection articulated by the Examiner in the second paragraph of point 5 of the final Office Action are mutually contradictory.

Therefore, the withdrawal of the double patenting objections is respectfully requested because the Examiner did not articulate any proper double patenting rejection.

35 U.S.C. §112 first paragraph:

E) Examiner has retained previous rejection under 35 U.S.C. §112 first paragraph in respect of claim 10a.

Applicant notes that the Examiner now finds claim 7 compliant with 35 U.S.C. §112 first paragraph.

In accordance with the Examiner's invitation to amend, Applicant proposes recasting claim 10a along the lines of the non-objectionable wording of claim 7 which is no longer found objectionable. The previous "under traditional management" qualifier now reads --under other non-volatile memory management schemes-. Support for the amendment is found in the original specification at page 9 line 29 to page 10 line 2. The amendment does not constitute a new matter as the Examiner has already considered the qualifier in examining claim 7.

Withdrawal of the rejection to claim 10a under 35 U.S.C. §112 first paragraph is respectfully requested.

Claim Rejections under 35 U.S.C. §103(a):

F) At point 15 of the second final Office Action, the Examiner has rejected claims 2 and 11 under 35 U.S.C. §103(a).

It is well established that in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine the teaching of the references. The Examiner must therefore produce "objective evidence of record" from the prior art showing motivation to combine these references and the reasonable expectation of success from such combination. They must also teach all of the limitations of the claims (see MPEP2143).

G) Applicant respectfully submits that independent claim 2 relates to a method of dynamically managing non-volatile memory items on a wireless device through a network, the method being performed when connecting to the network.

Compliant with the requirement of determining the scope and contents of the prior art confirmed in the recent KSR decision, Moore teaches away from the invention by describing an update method, the entire purpose of which is to avoid connecting to a network during an upgrade. Support for this assertion is found in numerous references to "offline" throughout Moore, and in particular, the title, the abstract, and the specification. Particularly, last sentence of paragraph [0005] reads: "The offline information may be used to determine a user's desired updates...".

Applicant respectfully submits that the Moore reference is non-analogous art because it teaches away from the invention.

Claim 2 depends from independent claim 1 and therefore incorporates all limitations thereof.

Therefore, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness in respect of claim 2 because the cited prior art does not teach each and every limitation of the claimed subject matter.

H) Applicant respectfully submits that the Examiner has failed to show a reasonable expectation of success from the combination of the Moore and Birum references.

Applicant respectfully submits that the showing of a reasonable expectation of success is particularly important in view of the fact that Moore teaches away from the claimed invention.

Therefore, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness in respect of claim 2 due to failure to produce objective evidence of record showing a reasonable expectation of success.

I) In rejecting claims 2 and 11 under 35 U.S.C. §103(a) the Examiner cites the Examiner's finding that Moore and Birum are in the same field of endeavor as reasons to combine the references.

Applicant respectfully submits that the Examiner did not provide necessary objective evidence of any teaching, motivation or suggestion for combining the references to enable an application of Section 103(a), as cited. In asserting U.S.C. 103(a), Applicant submits that the Examiner is required to provide such evidence. *In re Lee*, 61 USPQ2d 1430 (CA FC 2002) states that "[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness"; *In re Lee*, *supra*, also states that the rationale for combining references "must be based on objective evidence of record" and cannot be "resolved on subjective belief and unknown authority". See pages 1433 and 1434.

Applicant respectfully submits that the Examiner has rejected claims 2 and 11 based on subjective belief and unknown authority.

Therefore, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in respect of dependent claims 2 and 11, because the Examiner failed to produce objective evidence of record in support of the motivation to combine.

Response to Examiner's rebuttal of Applicant's arguments:

J) Applicant has reviewed the Examiner's response to Applicant's previous arguments.

Applicant respectfully disagrees with the Examiner's findings and in particular with the Examiner's assessment of the cited prior art. Applicant reiterates that, non-compliant with the Supreme Court's KSR decision, the Examiner:

- erred in determining the scope of the claimed subject matter,
- erred in determining the scope of the subject matter disclosed by Birum, and therefore
- articulated various rejections without basis.

Applicant respectfully pointed the above to the Examiner in the last paragraph on page 12 of the response to the first Office Action. The penultimate paragraph of MPEP §706.02(j) reads "It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply."

Without prejudice, Applicant respectfully retains all previous arguments on file.

The following arguments restate, at least in part, previous arguments from the point of view of a person skilled in the art having a mind willing to understand in an attempt to resolve remaining claimed element construction issues.

Claim Rejections under 35 U.S.C. §102(e):

K) The Examiner has rejected claims 1, 3 to 10a, and 10b under 35 U.S.C. §102(e) as anticipated by Birum.

The requirements of 35 U.S.C. §102(e) are strict. The alleged prior art must disclose all the features claimed. "A claim is only anticipated if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference".

Verdegaard Bros. v. Union Oil Co. of California, 2 USPQ2d 1051.

Therefore in order to establish a prima facie case of anticipation, the Examiner must cite a single prior art reference that teaches each and every element of the claimed invention to a person of ordinary skill in the art having a mind willing to understand and not desirous of misunderstanding.

L) In rejecting method claim 1 as anticipated by Birum, the Examiner is of the opinion that the claimed step of connecting a wireless device to a wireless network is shown in Figure 1 of Birum.

Applicant respectfully disagrees for the following reasons:

- Figure 1 of Birum does not show any method step. Support for this assertion is found at paragraph [0014] of Birum which reads "Fig[.]. 1[] show[s] components of an exemplary environment in which the [Birum] invention may be practiced; and
- Figure 1 of Birum does not show any wireless device. Based on the Examiner's correlation of the claimed wireless device with elements 140 described in Birum, support for the assessment that Birum does not show any wireless device is found at paragraph [0051] which reads: "Furthermore, computers, such as remote computer

140, and other related electronic devices can be remotely connected to either LANs 120 or WAN 130 via a modem and temporary telephone link.”.

The Examiner erroneously employs a stray reference to a wireless link in paragraph [0051] to erroneously assert that computer 140 of Birum connects wirelessly. Paragraph [0051] Birum reads: “Communication links within LANs typically include ... wireless links, ...”. A person of ordinary skill in the art would understand that the claimed wireless device connects to a wireless network and therefore the claimed wireless connection to a wireless network does not read on a wireless communication link within a network. To a person of ordinary skill in the art a connection within a network is a connection on the transport side of the network, while a connection to a network is a connection on the distribution side of the network. As pointed out herein immediately above, Birum teaches “modem and temporary telephone link” connectivity on the distribution side of the network.

As support for the assertion the Examiner states “Wireless is creating a wireless link therefore ...”. Applicant respectfully disagrees that the word ‘create’ or a synonym thereof is recited in paragraph [0051]. Therefore the Examiner failed to produce objective evidence of record to support the assertion.

Applicant respectfully submits that the Examiner failed to produce prior art teaching of the claimed wireless device in the process of connecting to a wireless network.

Therefore, Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of anticipation in respect of claim 1 because the Examiner failed to produce prior art teaching of each and every claimed element.

M) In rejecting method claim 10a as anticipated by Birum, the Examiner did not articulate where in the Birum reference did the Examiner find support for a wireless device.

The Examiner erroneously points to element 140 in Figure 1 of Birum as support for a network.

If, as the Examiner asserts, element 140 of Birum is a network, then Applicant respectfully submits that the Examiner failed to produce prior art teaching the claimed wireless device.

Therefore, Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of anticipation in respect of claim 10a because the Examiner failed to produce prior art teaching of each and every claimed element.

N) In rejecting method claim 10a as anticipated by Birum, the Examiner is of the opinion that the claimed step of registering a wireless device with a wireless network is described in paragraph [0051].

Applicant respectfully disagrees. Paragraph [0051] qualifies Figure 1. Figure 1 of Birum does not show any method steps. Support for this assertion is found at paragraph [0014] of Birum which reads “Fig[1]. 1[] show[s] components of an exemplary environment in which the [Birum] invention may be practiced.

The Examiner cites out of context a stray reference to an “intermediary device”. Applicant respectfully submits that the intermediary device cited by the Examiner is a router. The wireless device registering with a wireless network recited in claim 10a does not read on a router intermediary device described in Birum.

The Examiner further cites out of context a stray reference to "remotely connected".

Applicant respectfully submits that the remote connectivity described in paragraph [0051] is limited to "a modem and temporary telephone link." The wireless device registering with a wireless network recited in claim 10a does not read on a computer connecting to a network via a modem and telephone line described in Birum.

Applicant respectfully submits that the Examiner failed to produce prior art teaching of the claimed wireless device in the process of registering with a wireless network.

Therefore, Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of anticipation in respect of claim 10a because the Examiner failed to produce prior art teaching of each and every claimed element.

O) In rejecting claims 1 and claim 10a as anticipated by Birum, the Examiner relies on a stray reference to a "carrier wave" in citing prior art disclosure of the "an identifier indicating a carrier" claimed element.

Applicant respectfully submits that the Examiner did not apply accepted construction principles determining the scope of the carrier claimed element. MPEP §2111 entitled "Claim interpretation" at second paragraph reads: "The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.' *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004)."

In accordance with well accepted claim construction practice a person of ordinary skill in the art reading the specification with a mind willing to understand and not desirous of

misunderstanding would understand consistent reference in the specification to a telecommunication company when reference is made to a carrier. The Examiner erred in ascribing a secondary meaning of the word “carrier” that of a carrier wave while the specification does describe carrier waves.

Support for this assessment is found in the second paragraph of the originally filed specification wherein a person of ordinary skill in the art reading the specification with a mind willing to understand and not desirous of misunderstanding would not have read “a carrier’s requirements change after the build time” to mean that the inventor describes a carrier wave having changing requirements. Similarly, the description in the second paragraph on page 9 of the originally filed application would also be interpreted by a person of ordinary skill in the art with a mind willing to understand and not desirous of misunderstanding that carrier recitations therein refer to a telecommunications company.

Applicant respectfully submits that the Examiner failed to produce prior art teaching of the claimed carrier identifier.

Therefore, Applicant respectfully submits that the Examiner failed to establish a prima facie case of anticipation in respect of claims 1 and 10a because the Examiner failed to produce prior art teaching of each and every claimed element.

P) Dependent claims 3 to 9 depend directly or indirectly from independent claim 1 and incorporate all limitations thereof. Therefore, without prejudice, Applicant respectfully submits that the dependent claims 3 to 9 are novel for the same reasons stated herein above.

Q) In rejecting claim 3 under 35 U.S.C. 102(e) the Examiner relies on the description in Birum at paragraph [0045] which the Examiner cites as reading "... while modifying ...".

Claim 3 relates to a "writing step [being] performed after said updating step is complete."

Applicant respectfully submits that the claimed scope of "after" does not read on the cited prior art described scope of "while".

Applicant respectfully submits that the Examiner failed to produce prior art teaching of the claimed "after" qualifier ascribed to the claimed writing step.

Therefore, Applicant respectfully submits that the Examiner failed establish a *prima facie* case of anticipation in respect of claim 3 because the Examiner failed to produce prior art teaching of each and every claimed element.

R) In response to Examiner's rejection of claim 10b, Applicant proposes amending claims 10b and 11 to bring them in a condition for allowance.

Without prejudice, references to "wireless communications device" in claims 10b and 11 are amended to read --wireless mobile station--. Support for the amendment is found on page 4 last paragraph of the original application.

It is submitted that no additional subject matter has been introduced by the amendment.

Applicant respectfully submits that the amendment does not relate to a new matter as the Examiner has already construed the term mobile station present in the originally filed application.

Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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